

Appl. No. 09/506,342
In re HEINEY
Reply to Office Action of July 16, 2003

REMARKS/ARGUMENTS

This request for reconsideration is intended to be fully responsive to the Final Action mailed March 24, 2004.

In the Official Action, claims 1-6 were rejected under 35 U.S.C. 112, 6th paragraph as being single means claims having undue breadth. Applicant respectfully submits that pending claim 1 lacks any type of “means-plus-function” language as set forth in 35 U.S.C. 112, ¶ 6th. Indeed, claim 1 recites, among other things, “a photodetector having an active region and at least one interference coating” and this structural recitation removes claim 1 from the guidelines for §112, 6th paragraph treatment.

In an effort to expedite prosecution, application previously amended claim 1 to positively recite the position of the active region and interference coating relative to the electromagnetic signal moving in a direction along the path recited in the preamble of claim 1.

The prohibition against “single means” claims only applies to “means-plus-function” claims that invoke 35 U.S.C § 112, ¶ 6. *In re Hyatt*, 218 USPQ 195 (Fed. Cir. 1983).

It is well settled that 35 U.S.C. § 112, ¶ 6 does not apply “if the claim itself recites sufficient structure to perform the claimed function.” *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed. Cir. 2000) (holding “baffle means” element does not qualify for §112, ¶6 treatment because the baffle performs the stated function of the claim).

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Here, 35 U.S.C. 112, ¶6 does not apply to claim 1 because:

- (1) applicant does not use the term “means” in claim 1, and
- (2) claim 1 recites the structure necessary to perform the recited function.

According to MPEP 2181, a claim limitation will be interpreted to invoke 35 USC 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitation must use the phrase “means for” or “step for”;
- (B) the “means for” or “step for” must be modified by functional language; and
- (C) the phrase “means for” or “step for” must not be modified by sufficient structure for achieving the specified function.

Here, claim 1 fails to meet prongs (A) and (C).

Claim 1 does not include the phrase “means for” or “step for”; therefore, 112, ¶6 does not apply. *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000).

Additionally, it is well settled that, if the claim recites sufficient structure to perform the claimed function, the interpretation under 35 U.S.C. §112, ¶6 does not apply. *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 530-531 (Fed. Cir. 1996), *cert. denied*, 522 U.S. 812 (1997). Claim 1 recites the structure necessary to perform the recited function. Claim 1 recites “ ... a photodetector having an active region and at least one interference coating lying along the path... ”. The function recited in claim 1 is performed by this structure.


The foregoing rules are clearly set forth in MPEP 2181. 35 U.S.C. §112, ¶ 6

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does not apply. Therefore, claim 1 cannot be a "single means" claim as asserted by the Examiner.

For the foregoing reasons, it is respectfully submitted that claims 1-16 are in condition for allowance. Should the Examiner believe further discussion regarding the above claim language would expedite prosecution he is invited to contact the undersigned at the number listed below.

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